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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. 416

IN THE MATTER OF THE APPLICATION OF
ANDREW ALFORD

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 21–28) is reported at 300 F. 2d 929.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on April 13, 1962. A timely petition for rehearing was denied on June 8, 1962. The petition for a writ of certiorari was filed on September 6, 1962. Petitioner seeks to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review a decision of the United States Court of Customs and Patent Appeals, which affirmed the refusal of the

Board of Appeals of the United States Patent Office to grant an application for a patent.

2. Whether the United States Patent Office is required to confer a patent upon a combination of old elements merely because new and useful results are achieved.

STATUTES INVOLVED

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari.*—Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 103 provides:

> *Conditions for patentability; non-obvious subject matter.*—A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

Petitioner seeks review of the denial of his application for patents filed with the United States Patent Office.[1] The application relates to a coaxial choke

[1] Petitioner's initial application for a patent on the subject matter involved herein was filed on July 28, 1951 (R. 3) and subsequently abandoned. A later application was filed on July 10, 1956 (R. 3). By the Patent Office action dated April 22,

coupler for transmitting electrical signals or energy at what is described as high, very high and ultra high frequencies with a minimum of energy leakage (R. 3–17). The coupler includes an inner and an outer conductor (R. 5). The coupling of the inner conductor is accomplished by a quarter wave length sleeve-type coupler (R. 5–9). The coupling of the outer conductor is accomplished by a quarter wave length disc-type or flange coupler (R. 4–6). The Patent Examiner rejected petitioner's claims 19, 20, and 22 on the ground that his combination of prior inventions did not satisfy the standard of invention. He stated:

> Applicant's device is a co-axial coupler for high frequency operation. * * *
>
> Espley and Salisbury are also co-axial couplers for high frequency operation. The two references use sleeve-type quarter wave-length coupling for both the inner and outer couplers.
>
> Garfitt is also concerned with coupling high frequency energy in a co-axial line. Garfitt's inner conductor is solid, but since the outer conductor is divided into two portions rotatable with respect to each other, quarter wave-length coupling is provided for the outer conductor. This outer conductor coupling is shown alternatively as sleeve or disc type.

1958, all of the then pending claims were finally rejected (R. 21–22). New claims (R. 19–22) were substituted for the rejected claims in an amendment filed December 15, 1958 (R. 55). Claim 21 was thereafter allowed (R. 63) but the Examiner rejected claims 19, 20 and 22 (R. 61). Accordingly, they are the only claims in issue in the present litigation.

"R. —" refers to the transcript of record before the Court of Customs and Patent Appeals.

> Claims 19, 20 and 22 are not considered patentable over Espley or Salisbury in view of Garfitt [R. 61].
>
> * * * * *
>
> The contention that the combination produces a new and unexpected result is not considered persuasive since *the result set forth by applicant is inherent in the obvious combination of the references* and hence does not confer patentability on the claimed combination [R. 62–63; emphasis added].[2]

The Board of Appeals of the United States Patent Office, in its decision, dated July 29, 1960, affirming the Examiner's rejection, stated:

> In our opinion the substitution of a radial type joint such as shown in Fig. 3 of Garfitt for the joints of the basic reference would [be] obvious to one skilled in the art, since Garfitt teaches the interchangeable use of the longitudinal and radical choke joints for preventing radiation losses in a coaxial choke coupler [R. 66].

On October 28, 1960, petitioner, having previously notified the Commissioner of Patents as required by 35 U.S.C. 142 (R. 67), appealed to the United States Court of Customs and Patent Appeals (R. 1, 2). That court, on April 13, 1962, concluded that petitioner's device was not patentable under 35 U.S.C. 103. In so holding, it expressly concurred in the factual determination previously reached by both the Examiner

[2] The Espley, Salisbury and Garfitt patents constitute the prior art in connection with which petitioner's device, which combines portions of each of the three, must be measured to determine its patentability.

and the Board of Appeals that "A person of ordinary skill in the art, with the objective of providing a coaxial coupler for use in the range of frequencies here involved, would have found in Garfitt a suggestion that a disc type joint, as well as a sleeve type joint, could be used to reduce energy leakage or radiation from the separated outer conductor, such as the outer conductor of the Espley or Salisbury coupler" (Pet. App. 26).

ARGUMENT

As petitioner notes, this Court recently refused to rule on the question whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are reviewable on certiorari by this Court. *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. Similarly, there is no need for the Court to rule, and we take no position, on that question in this case. Even if this Court has jurisdiction, review in this instance is not appropriate. The question whether petitioner's application to the Patent Office disclosed a patentable invention is essentially one of fact, and the decisions of the Patent Office and of the court below are plainly correct.

1. In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, this Court held that a decision of the Court of Appeals of the District of Columbia, on appeal from a decision of the Patent Office relating to a patent and trademark application, was not a judicial determination but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. at 698–699. Since such a decision did not, in the Court's

view, present a justiciable case or controversy, it was deemed beyond the constitutional powers conferred upon this Court.

The jurisdiction of the Court of Appeals for the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction", citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

We assume, in light of this Court's opinion in *Glidden Company* v. *Zdanok*, 370 U.S. 530, that there is no constitutional obstacle to review by this Court of patent rulings of the court below. But the fact that the Court of Customs and Patent Appeals may now be viewed as an Article III court does not mean that certiorari jurisdiction automatically follows. It is necessary, beyond that, to establish that Congress intended to vest such jurisdiction in this Court.

To satisfy this jurisdictional prerequisite, petitioner invokes 28 U.S.C. 1256, *supra* p. 2 (Pet. 2). Section 1256 is part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code. Prior to that codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating

to customs cases. That provision—Section 195 of the old Judicial Code (36 Stat. 1145), as amended [3]—had two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[4] But nothing in the codifying Act of 1948 suggests that Congress had any intention of according power to review a class of cases over which jurisdiction had previously been withheld. Stern and Gressman, *Supreme Court Practice* (2d ed., 1954), pp. 47–50.

2. However, even if the Court were to decide that it now has jurisdiction to review patent decisions of the Court of Customs and Patent Appeals, there would be no occasion to exercise that jurisdiction in this case. The contention advanced by petitioner—that a new combination of old elements which produces a new and useful result is *prima facie* entitled to patent coverage—is refuted by many decisions of this Court and of the lower federal courts. In determining whether a combination of old elements is patentable, the crucial question is whether, conceding that the combination achieved new and useful results, uncommon "inventive" talent was required to con-

[3] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

[4] The Revisers Notes to Sections 1256 and 1541 confirm the derivation of those provisions.

struct it or to perceive that its construction would produce beneficial results. If anything is settled in our patent law, it is that a combination of elements does not constitute an invention to be rewarded with a patent monopoly if its creation required no more ingenuity than that possessed by ordinary mechanics acquainted with the business. *Hotchkiss* v. *Greenwood,* 52 U.S. 248, 260–263; *Textile Machine Works* v. *Hirsch Co.,* 302 U.S. 490, 497; *Cuno Corporation* v. *Automatic Devices Corp.,* 314 U.S. 84, 90; *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 340 U.S. 147, 150–152; *Stabler* v. *Bright Leaf Industries,* 261 F. 2d 383, 385–386 (C.A. 5), certiorari denied, 359 U.S. 960, rehearing denied, 359 U.S. 999; *Little Mule Corporation* v. *The Lug All Company,* 254 F. 2d 268, 275 (C.A. 5), certiorari denied, 358 U.S. 838; *Schick Service* v. *Jones,* 173 F. 2d 969 (C.A. 9); *Abbot Machine Co.* v. *Universal Winding Co.,* 137 F. 2d 166 (C.A. 1). It is significant that petitioner cites no authority for the position that the issuance of a patent is required merely because new and useful results are achieved by a combination of old elements.[5] New results, as

[5] In this regard, petitioner cites several decisions of this Court and of lower federal courts, and alleges that the decision below is in conflict with their teachings (Pet. 16, 17). Those cases, however, were patent infringement suits wherein the validity of an already issued patent was called into question. And it is settled by statute (35 U.S.C. 282) and case law (see *Radio Corporation of America* v. *Radio Laboratories Inc.,* 293 U.S. 1, 7; *Colgate-Palmolive Company* v. *Carter Products,* 230 F. 2d 855, 862 (C.A. 4), certiorari denied, 352 U.S. 843) that a patent once issued is presumed to have been validly issued. Therefore, it is not surprising that, in looking to sustain the patent office's decision to confer a patent, it was noted that bene-

this Court stated in the very passage of *Loom Company* v. *Higgins*, 105 U.S. 580, 591, cited by petitioner (Pet. 16), are but "*evidence of invention*" (emphasis added).

The opinion below clearly demonstrates that the Court of Customs and Patent Appeals accorded evidentiary weight to the beneficial results achieved by petitioner's device (Pet. 25, 26). It concluded, however, that one with ordinary skill in the art, desirous of producing a coaxial coupler for use in the 100 to 5000 megacycle frequency range, would have been able to construct, with aid of the references, the combination device in question, and that, upon such construction, the beneficial results would have appeared obvious (Pet. 26).[7] Therefore, the court below did

ficial results were derived from the combination. This does not indicate, however, that the patent office had not considered other factors as well. Moreover, even if the only factor in favor of patentability in each of these cases was the results achieved, this involves a factual inquiry. This being the case, it cannot seriously be contended that a conflict exists.

See also *Glikin* v. *Smith*, 269 F. 2d 641 (C.A. 5), certiorari denied, 361 U.S. 915, wherein it was pointed out that, although the benefits obtained from a combination are indicia of "invention," "[t]he vital question * * * in spite of the benefits, is always whether mechanical aptitude or inventive skill produced the benefits." 269 F. 2d 641, 652.

[7] It is settled that a patent should not be granted for the discovery of results that would flow naturally from the teachings of the prior art. *Application of August H. Heinrich*, 268 F. 2d 753, 756 (C.C.P.A.); *In re Busch*, 251 F. 2d 617, 618 (C.C.P.A.); *In re Kepler*, 132 F. 2d 130, 133 (C.C.P.A.) "A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 150–153.

not, as petitioner contends (Pet. 16), disregard the test laid down by this Court in *Loom Company* v. *Higgins, supra*. Rather, the court applied that test and concluded that, considering the results achieved together with the additional surrounding facts, petitioner's device did not satisfy the requirement of "inver ion."

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.
JOSEPH D. GUILFOYLE,
Acting Assistant Attorney General.
MORTON HOLLANDER,
EDWARD BERLIN,
Attorneys.

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